



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/217,117	12/21/1998	YASUTOMO NISHINA	450100-4033.	8734

20999 7590 09/10/2003

FROMMER LAWRENCE & HAUG  
745 FIFTH AVENUE- 10TH FL.  
NEW YORK, NY 10151

EXAMINER

HAILU, TADESSE

ART UNIT	PAPER NUMBER
----------	--------------

2173

DATE MAILED: 09/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

4

# Office Action Summary

Application No.  
09/217,117

Applicant(s)  
Yasutomo Nishina et al.

Examiner  
Tadesse Hailu

Art Unit  
2173



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Aug 13, 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 4-10, 12, and 16 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-10, 12, and 16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some\* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 08/893,878.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

Art Unit: 2173

---

### **Detailed Action**

1. This Office Action is in response to the RCE Request entered August 13, 2003 for the patent application (09/217,117) filed December 21, 1998.

### ***Priority***

2. The present patent application claims priority from a foreign application (08-214073) filed 26 July 1996.

### ***Status of the claims***

3. Claims 3, 11, 13-15 are canceled by applicant and the pending claims 1, 2, 4-10, 12, and 16 are examined.

### ***Claim Rejections - 35 U.S.C. § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) the patent may not be obtained though the invention is not identically disclosed or described as set forth in section 10" of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 2, 4-10, 12, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,589,892 (Knee et al), U.S. Patent No. 5,047,867 (Strubbe et al), and U.S. Patent No. 6,424,790 (Ishii et al).

Referring to claims 1 and 4, Knee provides an apparatus for controlling an electronic program guide (EPG) (see Knee: fig. 1), wherein the EPG system is provided with data feeds

Art Unit: 2173

---

containing different types of information and is selectable for display by the user on an on-demand basis. Knee's EPG system further provides storage for information obtained from received data feeds (broadcast program), the information relative to a number of broadcast programs extracted from predetermined positions of video signals (see Knee: col 6, lines 40-60, col 45, lines 8-17). Knee further discloses a storage for program schedule information, wherein the program schedule information comprises an identification of teams (names) participating in a live sporting event and the channel on which the event is being broadcast including information identifying the title and time of said event (see Knee- col 36, lines 52-61, col 46, lines 46-55, col 48, 30-44). Knee further shows (Fig. 1) and describes various components (hardware and software) of electronic program schedule systems. Physically, the components can be mounted in a separate housing, or included as part of a TV, VCR , etc (col 9, lines 50-58).

Knee, however, does not explicitly show recording medium identification information or recording start and end position information. Strubbe, though, describes storing information and displaying program name information (Figs. 10a, d) and recording medium identification information (Fig. 4, H, tape # 3 and #5). Furthermore, Strubbe indicates a third store for storing information concerning programs on other tapes of the user wherein the tapes are designated by recording medium identification numbers such as tape numbers (see Fig. 4, H, tape #3 and #5). Thus a user can identify which tape contains his favorite show or program.

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to incorporate the operation and control of a recording medium (VCR)

Art Unit: 2173

---

of Strubbe as part of Knee's component system. Thus, by incorporating the recording medium (VCR) of Strubbe a user will be able to record a plurality of programs for later viewing at any convenient time.

While Knee and Strubbe teach most of the limitations of the present invention, but Knee and Strubbe fail to teach the recording start position and end position on the respective recording medium which is entirely viewable by the user. However, Ishii discloses recording start and end position information for each recorded program (see Ishii: col 35, lines 40-58 and col 36, lines 5-21). Ishii further describes that the start and end position information can be verified by the user so that the exact location of a desired program can be located easily. Accordingly, it would have been obvious to one having ordinary skill in the art at the time the present invention was made to incorporate the recording and displaying of start and end position information as taught by Ishii in the system of Knee and Strubbe so that a user could locate a desired program in an efficient manner.

Furthermore, Knee, Strubbe, and Ishii discloses a display control means capable of displaying an electrical program guide comprising program-related information (see Knee: col 6, lines 40-60). Furthermore, since the information display of Knee is customizable (such as, setting favorites channels, locking channels, setting recording times, moving the superimpose horizontal bar to top or bottom of the display, etc), modifying the information display of Knee by Strubbe and Ishii results in displaying start and end position of recorded information on the predetermined portion, such as the horizontal bar (figs. 11-14, etc) of Knee. Also, all other

Art Unit: 2173

---

information such as the program listing will be viewed on the wider portion of the display (figs. 11-14, etc.).

Also disclosed is the setup Of recorded program information (see Strubbe: figs. 6b and 8b or 8d). The electronic program guide Of Knee's further demonstrates that information from the stored program schedule information (Abstract) is combined with information obtained from received data feeds and displayed simultaneously (see Knee: col 6, lines 40-60). The program guide system also provides the capability of selecting from among several user-defined channel presentation sequences, which are activated using one of the three "check mark" icon keys 48A, 48B or 48C on the remote controller 40 shown in FIG. 4. (see Knee: col 27, line 56-col 28, line 5). Once a particular entry is selected, the electronic program guide connects the user to the selected service and passes control to the particular service application software, as shown in FIGS. 32-35.

Referring to claims 2 and 5, as per "... said display control means is capable of displaying simultaneously as an electrical program guide, at least a program information area in the form of a window to display the program information, a command area in the form of a window to display items for selecting a manipulation command relative to said program guide, and an input area in the form Of a window to display items for inputting a required parameter corresponding to the selected manipulation command." Knee, Strubbe, and Ishii further disclose that the information from the stored program schedule information is combined with information obtained from received data feeds and displayed simultaneously. Knee further

Art Unit: 2173

---

provides selectable displayed items (such as menu items or commands) for input manipulation and processing (see Figs. 6-8).

Referring to claim 6, as per "...wherein said recorded program information stored in said recorded program information storage means includes the recording start positions of the broadcast programs in said recording media." Knee, Strubbe, and Ishii further disclose recording start positions of the broadcast programs in the VCR (recording media) (see Ishii: col 35, lines 40-58 and col 36, lines 5-21).

Referring to claim 7, as per "... wherein said display control means displays the program information relative to both of the broadcast programs and the recorded programs, in a manner to superimpose such information on a normal picture." Knee, Strubbe, and Ishii disclose this limitation (see Strubbe: figs.6b, 14a and 14b).

Referring to claim 8, as per "..., wherein said display control means displays the program information relative to both of the broadcast programs and the recorded programs, in a manner to superimpose such information on a fixed picture." Knee, Strubbe, and Ishii further disclose a "freezing" or fixed picture-in-picture (PIP) representation of a scene from a particular program being broadcast (see Strubbe: col 12, lines 49-56). Additionally, a graphic overlay 51 containing programming information for the channel currently tuned on the tuner is superimposed in overlaying relationship with a received program signal (see Knee: col 14, lines 3-18).

Referring to claim 9, as per "..., wherein said display control means has a mode to display the program information relative to the broadcast programs, on the basis of the broadcast program

Art Unit: 2173

---

information stored in said broadcast program storage means; and a mode to display the program information relative to the recorded programs on the basis of the recorded program information stored in said recorded program information storage means." Knee, Strubbe, and Ishii disclose that the EPG further provides the user with the ability to select from among a plurality of display formats for the program schedule information (see Knee: col 5, lines 1-7, col 9, lines 21-24, col 11, lines 32-48, col 12, lines 39-63, col 21, lines 21-35, col 29, lines 16-47, col 40, lines 10-27).

Referring to claim 10, Knee, Strubbe, and Ishii disclose that the EPG further provides the user with the ability to select from among a plurality of display formats for the program schedule information (see Knee: col 5, lines 1-7, col 9, lines 21-24, col 11, lines 32-48, col 12, lines 39-63, col 21, lines 21-35, col 29, lines 16-47, col 40, lines 10-27).

Referring to claim 12, as per "..., wherein said display control means displays the mode, which is currently set, in a portion of said program information area." Knee, Strubbe, and Ishii disclose that the EPG system further provides a flexible program schedule system that allows a user to view selected broadcast programs on a portion of the screen of the television receiver while simultaneously viewing program schedule information for other channels and/or services on another portion of the screen (see Knee: col 4, lines 26-39, col 6, lines 1-28, col 15, lines 41-64).

Referring to claim 16, as per "..., wherein said display means has a plurality of modes with regard to display of the command area, and displays command icons corresponding to each selected mode." Knee, Strubbe, and Ishii disclose that the plurality of display formats further



Art Unit: 2173

---

provides user selectable icons (such as check-mark icons 48a-c) (see Knee: col 6, lines 1 -28, col 12, lines 39-63, col 29, 16-48).

### ***Response to Arguments***

5. Applicant's arguments filed 8/13/2003 have been fully considered but they are not persuasive. Applicant argues that the present invention (claims 1, 2, 4-10, 12 and 16) is distinguishable from proposed combination of Knee, Strubbe, and Ishii. Specially the applicant argues that the limitations of the independent claims are not provided by the proposed combination of Strubbe and Ishii. In contrast to the applicant argument the combination of the prior art of records teaches the present invention. The combination of Knee, Strubbe, and Ishii shows a horizontal bar (predetermined portion area) (see Knee: Figs. 5-14, etc) for displaying start and end positions of a recorded programs (as described in Ishii), and a wider portion area for displaying other programs such as program listings.

Having fully addressed the Applicant's argument, the rejection still stands.

### ***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to *Tadesse Hailu*, whose telephone number is (703) 306-2799. The Examiner can normally be reached on M-F from 10:00 - 7:30 ET. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, *John Cabeca*, can be reached at (703) 308-3116 Art Unit 2173 CPK 2-4A51.


Art Unit: 2173

---

7. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.
- 

*Tadesse Hailu*

September 4, 2003



JOHN CABECA  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100